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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/797,303

03/09/2004

Gary Weller

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7590

01/05/2007

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EXAMINER

ANDERSEN, MICHAEL T

ART UNIT

PAPER NUMBER

3734

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/797,303		Applicant(s) WELLER ET AL.	
	Examiner M. Thomas Andersen		Art Unit 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4/26/2004, 5/24/2004, 2/18/2005, 8/24/2005, 10/16/2006.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statements (IDS) received on 4/26/2004, 5/24/2004, 2/18/2005, 8/24/2005 and 10/16/2006 are acknowledged. The submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Election/Restrictions

Applicant's election with traverse of Species I in the reply filed on 10/16/2006 is acknowledged. The traversal is on the ground(s) that independent claims 1, 7 and 21 are generic and read on all of the species identified by the Examiner. This is not found persuasive because the presence of generic claims is irrelevant to the question of whether the restriction was proper. If the generic claims are held allowable, the non-elected species will be rejoined and will receive patent protection. The non-elected species are still deemed to be patentably distinct and regardless of the presence of generic claims, the restriction prevents future addition of claims in this application that read solely on the non-elected species.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

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by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-15, 17-24 and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Demarais, U.S. 2005/0192599.

Demarais discloses various apparatuses and methods for reducing hollow body organ volume.

Claims 1, 5, 7, 21: Figures 69-70 show a gastroplasty device having two acquisition members in apposition to one another along a first longitudinal axis, and the acquisition members are adapted to adhere tissue thereto such that the tissue is positioned between the two acquisition members. The gastroplasty device further comprises a distal working portion having a longitudinal axis, a perimeter and an inner volume; and a vacuum chamber adapted to adhere tissue. Demarais ¶ 149.

Claims 2, 12: The acquisition members are movable relative to one another and relative to the longitudinal axis between a delivery configuration and a deployment configuration.

Claims 3, 10: The device further comprises an elongate body 735. Demarais Fig. 70.

Claim 4: The longitudinal axis defined by the elongate body is parallel with a longitudinal axis defined by the apparatus. Demarais Fig. 70.

Claims 6, 11, 26: The device further comprises a septum removably positioned between the first and second acquisition members.

Claims 8-9: The distal working portion can be said to have a rectangular or an arcuate configuration.

Claims 13-14, 22-23: The device further comprises an expandable element consisting of a balloon. Demarais ¶ 141.

Claims 15, 24: The device is adapted to be used with an endoscope. Demarais ¶ 135.

Claim 17: The tissue acquisition member is pivotally movable relative to the septum. Demarais Fig. 69.

Claims 18-19, 27-28: The septum comprises a bioabsorbable material, e.g. polylactic acid. Demarais ¶ 152.

Claim 20: The tissue acquisition member comprises a cartridge assembly containing at least one fastener (staples) therein for affixing to tissue. Demarais Fig. 69.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 16 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Demarais.

Demarais does not explicitly disclose a transducer used with his device. However, it is well known to use a transducer with a vacuum, such as one described by Demarais, in order to tell the pressure at the anvil portion prior to stapling the tissue.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Thomas Andersen whose telephone number is (571) 272-8024. The examiner can normally be reached on M-F 8AM-4:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Thomas Andersen
December 16, 2006



MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER